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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,991	03/02/2004	Mikhail Lotvin		1319
33283	7590	01/10/2008		
RICHARD MICHAEL NEMES 754 WEST BROADWAY WOODMERE, NY 11598-2948				
			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/790,991	LOTVIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 and 29-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/02/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to communication filed on 10/18/2007.
2. Claims 1-26 and 29-74 have been cancelled. Claims 27, 28, and 75-79 are presented for examination.
3. Amendments to the claims 27, 28, and 75-79 have been entered and considered.

### **Objections**

4. *Applicant's claim amendments require the Applicant to renumber the claims accordingly. For example, claim 28 depends from claim 75, and it is listed before claim 75. Appropriate correction is required.*

### **Note**

5. *The Examiner had made a typo in the month and day cited for the Valupage.com website (www.valupage.com) (from date 12/03/1998 captured by the Wayback Machine Internet Archives) (hereinafter Valupage) reference. This has now been corrected.*

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. *Claims 27, 75, 77, and 79 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura et al. Patent Number 6,076,101 (hereinafter Kamakura) in view of the article by Shannon Obendorf, titled "Points for loyalty," from Catalog Age,*

*December 1997, Vol. 14, Iss. 13, pg. 35 (hereinafter Obendorf).*

In reference to claim 27, Kamakura discloses a method of providing advertisement to a user communicating with an advertising entity over a network, comprising: sending e-mail comprising an advertisement message specifying a monetary value associated with the advertisement (col. 1 lines 61 to col. 2 lines 13), wherein the monetary value is displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67); *and enabling the user to realize the monetary value associated with the advertisement, comprising the steps of: electronically providing the user with purchasing choices consistent with the monetary value (col. 9 lines 10-53).*

*Kamakura does not specifically teach electronically determining the user's selection and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection. Obendorf teaches electronically determining the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3) and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include electronically determining the user's selection and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection in Kamakura's invention to enable the users to*

*redeem their points with retailers that offer products of interest to the users from the convenience of their home by using their computers to order their award items.*

7. *In reference to claim 75, Kamakura teaches the method further comprising receiving a response from the user indicating that the user has opened the e-mail (col. 3 lines 7-8, 40-43, and 60-63, col. 4 lines 22-23, col. 5 lines 3-4, and col. 7 lines 23-29); and transferring the monetary value specified in the e-mail to account of the user (col. 2 lines 8-13, col. 3 lines 10-13 and 43-48, and col. 8 lines 15-28).*

8. *In reference to claim 77, Kamakura teaches the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42).*

9. *In reference to claim 79, Kamakura does not teach the method further comprising electronically receiving a commission from the third-party supplier of goods or services. Obendorf teaches the method further comprising electronically receiving a commission from the third-party supplier of goods or services (i.e. Edmund Scientific sells products to MotivationNet at a discount, and they buy MyPoints for \$0.016 per point and MotivationNet buys back redeemed points for \$.01) (page 2 paragraph 6). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Kamakura's invention electronically receiving a commission from the third-party supplier of goods or services to enable the reward program administrator to generate revenues by bringing business to third-party suppliers of goods or services by introducing new customers to the third-party suppliers.*

10. Claim 28 is rejected under U.S.C. 103(a) as being unpatentable over Kamakura

in view of *Oberndorf* and further in view of the Valupage.com website (www.valupage.com) (from date 12/03/1998 captured by the Wayback Machine Internet Archives) (hereinafter Valupage).

In reference to claim 28, Kamakura teaches the use of conditions in determining the transfer amount of monetary value to the user's account (col. 5 lines 24 to col. 6 lines 11 and col. 7 lines 30 to col. 9 lines 9). Kamakura is silent about teaching not transferring the money value to the user's account when the expiration date condition is not met. ValuPage teaches specifying an expiration date (i.e. the savings are just for this week, *even though an expiration date is not written out on this printout, it is inherent that when it is stated on the print out that these are the ValuPage savings for this week, this week is a duration of a week, and the offers expire at the end of the week when next week's ValuPage will be released*) (see ValuPage print out lines 8 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include an expiration date condition in Kamakura's invention for the advertising messages to encourage the user to quickly redeem the offer, to maintain an accurate record of how many credits have been rewarded for a given campaign during a specific time period, and to make sure the user's access the information in a meaningful timeframe. And, even though the ValuPage invention is depicted as being carried out on a website in the printed embodiment, it could have easily been pasted in the body of the e-mail message itself.

11. *Claim 76 is rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of Goldhaber et al. Patent Number 5,855,008 (hereinafter Goldhaber).*

*In reference to claim 76, Kamakura teaches the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42). Kamakura does not specifically teach displaying the point value as currency. Goldhaber teaches displaying the point value as currency (col. 7 lines 5-11 and 51-54, col. 12 lines 55-61, and col. 16 lines 12-23). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Kamakura's invention the display of the monetary value as currency to enable the users to know how many award dollars they are spending on a given award so that that the user can compare the dollar award value to what the item might cost in a store easily rather than having to try to convert how many points equate a dollar value of the item in a store.*

12. *Claim 78 is rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of Official Notice.*

*In reference to claim 78, Kamakura teaches the identification of bonus points in a subject line of the transmitted e-mail (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67). Kamakura does not teach specifically the identification of the advertised product or service in a subject line of the transmitted e-mail. Official Notice is taken that it is old and well known to identify an advertised product or service in a subject line of the transmitted e-mail. For example, when a user receives e-mails from retailers, the*

*subject line may say all DVD's on sale, business books on sale, fall coat sale, all shoes on sale, etc. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included identification information regarding an advertised product or service in a subject line of the transmitted e-mail to enable the user to know before opening the e-mail, if the e-mail is regarding a product that is of interest to the user at that given time.*

**Response to Arguments**

13. After careful review of Applicant's remarks/arguments filed on 10/18/2007, the Applicant's arguments with respect to claim 28 had been fully considered but are moot in view of the new ground(s) of rejection. Amendments to claims 27, 28, and 75-79 have been entered and considered.

14. Applicant argues that the ValuPage reference provides the amount of aggregate discounts available during a given week, but this aggregate number does not suggest that any of the available discounts expire at the end of the week. The Examiner respectfully disagrees with the Applicant; since ValuPage recites, "Just a few of the leading brands helping you save over \$42.00 with this week's ValuPage," and this means the savings are just for this week. Even though an expiration date is not written out on this printout, it is inherent that when it is stated on the print out that these are the ValuPage savings for this week, this week is a duration of a week, and the offers expire at the end of the week when next week's ValuPage will be released.

15. Applicants additional remarks addressed to the new claim limitations have been addressed in the rejection necessitated by the amendments.



**Conclusion**


16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

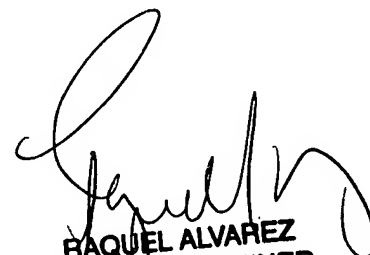
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197.

NB

  
January 5<sup>th</sup>, 2008

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER